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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,401	07/30/2001	John P. Moyna	CJM-P-01-001	4664
29013	7590	10/16/2007		
PATENTS+TMS, P.C. 2849 W. ARMITAGE AVE. CHICAGO, IL 60647			EXAMINER MCGOWAN, JAMIE LOUISE	
			ART UNIT	PAPER NUMBER
			3671	
			MAIL DATE	DELIVERY MODE
			10/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/918,401

Applicant(s)

MOYNA, JOHN P.

Examiner

Jamie L. McGowan

Art Unit.

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) 10-34 and 38-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election of Group I in the reply filed on 08/09/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 6, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayse (2,905,254).

Regarding claim 1, Hayse discloses an apparatus for separating soil comprising:

- A frame (7, 8, 9, 10, 11, 12) having a length defined between a first end of the frame (9) and a second end of the frame (10)
- An axle (17,66,67,68,69) connected to the frame between the first end of the frame (9) and the second end of the frame (10) wherein the axle has a length defined between a first end of the axle (17) and a second end of the axle
- A cylinder (76) connected to the frame wherein the cylinder (76) has peripheral walls defining an interior wherein the cylinder has a portion extending outward with respect to the interior of the cylinder wherein the portion is movable with respect to the interior of the cylinder wherein the portion of the cylinder is located between the frame and the axle (attached between frame portions (11,12) and axle (17) – Figure 1)

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- Discs (3,4,5,6) attached to the frame on opposite sides of the axle (17) wherein at least one of the discs adjacent to the first side of the frame (9) is non-parallel with respect to at least one of the discs adjacent to the second side of the frame (10) wherein the discs are located between the frame and the soil and further wherein the discs rotate upon contact with the soil
- A controller (not shown but considered to be the controller that controls 76) associated with the cylinder (76) wherein the controller is remote with respect to the frame (operated remotely via cables 79 and 80) wherein the controller controls movement of the frame via the cylinder (76) wherein the discs are moved with the frame and further wherein the cylinder extends between the axle and the frame to move the frame and the discs with respect to the axle (when the cylinder is actuated the wheels are moved and because of the movement of the wheels, the discs (which are attached to the frame) are moved to penetrate the soil. Therefore the cylinder acts to move the discs and the frame with respect to the axle.

Regarding claim 2, Hayse discloses that the cylinder is a hydraulic piston (column 4 lines 5-10).

Regarding claim 6, Hayse discloses that the apparatus further comprises a hitch having a length defined between an end of the hitch and a connector (92) of the hitch wherein the end of the hitch is attachable to the frame.

Regarding claim 7, the connector (92) rotates in a first direction and a second direction wherein the first direction is opposite to the second direction (the fact that the connector is attached to the tractor with a pin allows the connector to rotate about the pin in opposite directions when the frame and the tractor encounter undulations in the field).

Regarding claim 8, Hayse discloses that there are wheels (70,71) connected to the frame, wherein the wheel supports the frame.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayse (2,905,254) in view of Fruth (3,331,638).

While Hayse discloses the device above, it fails to disclose a plug in the wheel of the frame. Like Hayse, Fruth also discloses a wheel. Unlike Hayse, Fruth further discloses a plug in the wheel for an oil bath to keep the wheel and bearings lubricated. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include an oil bath and plug in the wheel of Hayse as taught by Fruth to keep the bearings and the wheel well lubricated to prevent damage to any of the parts.

5. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayse (2,905,254) as applied to claim 1 above, and further in view of Kinzenbaw et al. (5,346,019).

Regarding claims 3-5, Hayse discloses the invention as described above but fails to disclose a pillar connected to the frame and a column inside the pillar. Like Hayse, Kinzenbaw et al. also discloses a work implement that raises and lowers the frame for transport. Unlike Hayse, Kinzenbaw et al. further discloses a pillar (118) and a column (100b) inside the pillar (118), a liner (180b) inside the pillar and plates (182b) inside the

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pillar and supporting the column of the lifting mechanism. Kinzenbaw et al. teaches that his lifting mechanism is desirable because it allows the operator to rotate the frame about a vertical axis for transport on a road. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the lifting mechanism of Kinzenbaw et al. in the implement of Hayse to make transport of the frame easier by allowing the operator to transport the frame on narrow roads.

### ***Response to Arguments***

6. Applicant's arguments filed 06/05/2006 have been fully considered but they are not persuasive. Regarding the Hayse reference, applicant argues that Hayse does not disclose the cylinder being located between the frame and the axle. However, as viewed from above (Figure 1) the cylinder is clearly located between the axle (17,66,67,68,69) and the frame sections (11,12). Applicant further argues that the controller does not control movement of the frame. The examiner disagrees. As explained above, when the controller is actuated the wheels are pivoted to a non-transport position. When the wheels are no longer in contact with the ground the discs are allowed to penetrate the soil to perform the soil separating operations. Therefore, when the wheels/axle are moved by the controller, the frame and the discs are also moved by the controller. Further, applicant's arguments with respect to the controller's affect on the frame seem to be more specific than what is actually disclosed in the claims i.e. "nowhere does Hayes disclose that the cylinder moves the frame at an angle with respect to the axle as required by claim 1" (applicant's arguments 06/05/2006 page 17).

7. Applicant's arguments with respect to claims 1-9 filed 12/1/2006 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie L. McGowan whose telephone number is

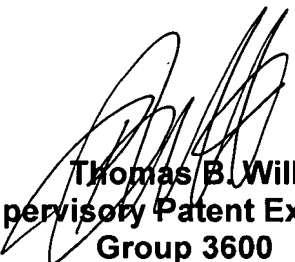
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(571)272-5064. The examiner can normally be reached on Monday through Friday 8:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on (571)272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jamie L. McGowan  
October 4, 2007



**Thomas B. Will**  
**Supervisory Patent Examiner**  
**Group 3600**